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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,037	02/26/2002	Meang K. Chia	B-4496PCT 619513-8	9827
36716	7590	08/10/2004	EXAMINER	
LADAS & PARRY 5670 WILSHIRE BOULEVARD, SUITE 2100 LOS ANGELES, CA 90036-5679			MITCHELL, KATHERINE W	
			ART UNIT	PAPER NUMBER

3677

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/070,037

Applicant(s)

CHIA ET AL.

Examiner

Katherine W Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 131-137 and 139-147 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 131-137, 139-142 and 145-147 is/are rejected.
- 7) ☒ Claim(s) 143 and 144 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: page 1 only - WO 01/13754 A1 showing priority claimed.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. The request filed on 6/10/2004 for a Request for Continuing Examination (RCE) under 37 CFR 1.114 is acceptable and an RCE has been established. Any previous finality is hereby withdrawn and a new action on the merits follows. Any newly-submitted claims have been added. An action on the RCE follows.

2. The status of the claims prior to this action is:

- claims 1-130 and 138 previously cancelled;
- claims 131-137, 139-142, and 145-147 previously rejected and pending;
- claims 143-144 previously objected to as depending on rejected claims, but having allowable subject matter and pending.
- A terminal disclaimer has been entered and approved.

Priority

3. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120, 121, or 365(c) as follows:

- This application is claiming the benefit of a prior filed nonprovisional application under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required. Applicant claims priority to 09/224,936. However, 09/224,936 was not copending at the time the application was filed. Applicant states that the copendency is through PCT US00/18389; however, PCT US00/18389 did not claim priority to 09/224,936. For clarity,

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examiner is providing the first page of WO/13754 A1, PCT application number US00/18389, clearly showing that no priority was claimed to 09/224,936.

Oath/Declaration

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02. The oath or declaration is defective because: as discussed under "Priority" above, it claims priority to an application from which valid priority cannot be claimed.

Drawings

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "263" has been used to designate both sidewall, segment, and what appears to be an opening (Figs 60-61).

6. The drawings are objected to because in Fig 75, "364" is never identified. Examiner has tried to review all 89 drawings for other instances of this feature and is unable to find it identified elsewhere. Examiner assumes "364" is the retainer of claim 135; however, this must be properly identified in the specification. The drawings have not been objected to under 37 CFR 1.83(a) under the assumption that "364" is the claimed retainer. The drawings must show every feature of the invention specified in the claims. Therefore, if "364" is not the retainer, it must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

7. The 89 drawings include multiple species and embodiments, and have not been checked to the extent necessary to determine the presence of all possible minor errors.

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Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

8. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

9. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory

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material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

10. The attempt to incorporate subject matter into this application by reference to non patent literature (page 44, lines 13-17) and US patent application 09/383814 is improper because non-patent literature cannot be incorporated by reference, and 09/383814 also includes material incorporated by reference (paragraph 85). An application cannot incorporate by reference another application that incorporates material by reference.

11. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

12. The disclosure is objected to because of the following informalities:

- Page 32, lines 5-12 describe Fig 56 with pockets 239 and also base 239.
- Page 32, lines 13-19 describe Fig 57 with pockets 243 and also base 243.
- Page 32, lines 20-25 describe Fig 58 with pockets 247 and also base 247.
- Page 33, lines 12-20, reference character "263" is used interchangeably multiple times to identify both sidewall 263 and segment 263.
- Page 38, line 3, "sis' apparently should be --is--.
- Page 23, line 23, "they-appear" should not have a hyphen.

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- Page 34, lines 23-24 have areas of very faded/blank typing. While this may be a result of copying, if and when this application issues, it is likely that the printer will be unable to accurately determine the wording.
- There are numerous examples of “plate-like” in the specification, for example:
 - Page 17, line 8
 - Page 36, line 7
 - Page 38, lines 7-9 and 15
 - Page 40, lines 1-2
 - Page 41, line 25

However, there is nothing to indicate what makes an item “plate-like”. For example, page 41 states that the objects and inserts are “merely examples of an unlimited number of shapes and configurations”, and page 37, lines 5-9, state that the base member may have a “plate, or strap or tab”, thus equating the three.

- Page 42 discloses “material (metal) “ that may vary, which indicates that different metals may be used. However, later in the same paragraph, plastic is disclosed as a possible material, thus “(metal)” should be deleted as it implies that material is synonymous with metal.

Appropriate correction is required.

Claim Objections

13. Claims 134-137, 142-144, and 146-147 are objected to because of the following informalities:

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- Claims 134-137 and 142 recite the limitation “plate-like”, and claims 146-147 recite the limitation “plate-shaped”. As discussed above under “Specification”, there is nothing in the specification to indicate what makes an item “plate-like”. Claims 146-147 recite “plate-shaped”. As also discussed under “Specification”, there is nothing in the specification to indicate what makes an item “plate-shaped” since “unlimited” shapes are envisioned. Claims 143-144 are objected to as depending from claim 142.
 - Claim 137 is also objected to as indefinite as it recites “below said top”, but claim 137 depends from claims 134 and 131. Claim 131 discloses a base member top, and claim 134 discloses a decorative insert top; thus it is unclear to which top “said top” refers. Examiner will assume for purposes of examination that applicant intended the base member top.
- Appropriate correction is required.

Claim Rejections - 35 USC § 102

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

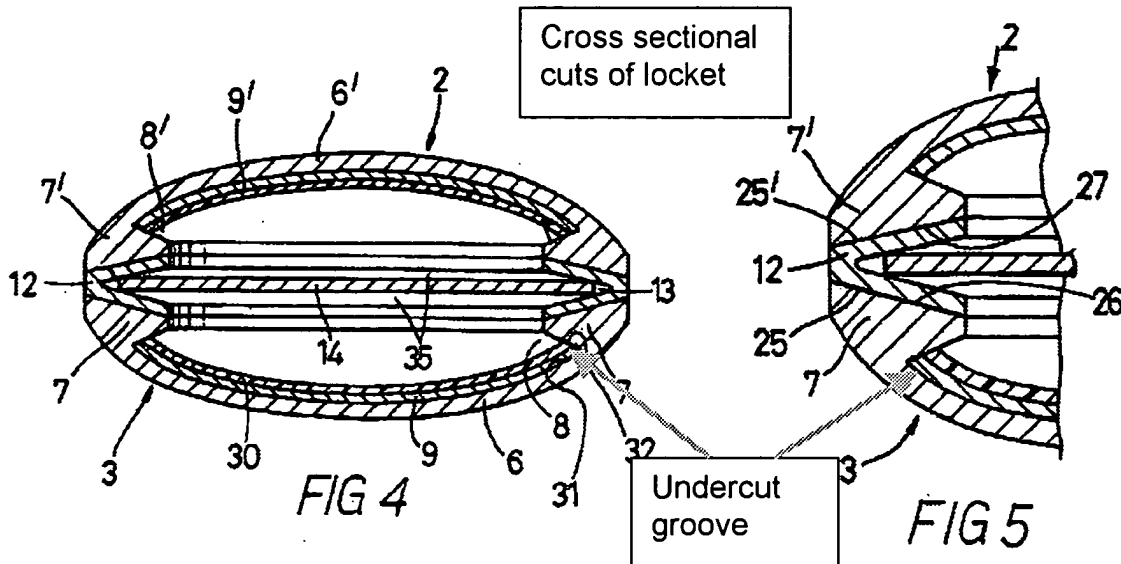
Claims 131-133, 136, 139-141, 145-146 are rejected under 35 U.S.C. 102(b) as being anticipated by Taylor US Patent 5651274.

Re claims 131 and 139 and 145-146: Taylor teaches a decorative jewelry item (loket 1) comprising a base member (2 or 3 - the two halves comprising the loket) as

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seen in Figs 1-4 and described in column 2 line 2 - column 3 line 64. Referring to base member 3, the back section or cover, the base member 3 has:

- a hollow interior (fig 4, #8, described in column 2 lines 63-66)



- a top with an opening therein leading to said hollow interior (cover rim surface 25 seen in Fig 5 and column 2 lines 63-64)
- a bottom (6)
- and a sidewall extending from said top to said bottom (# 7 in Fig 4 and 5 and described in column 1 lines 52-56);
- a decorative insert configured and sized in relation to base member top opening to be inserted through top opening into said hollow interior and entirely positioned below said top (photograph 9. column 2 lines 66 - column 3 line 2)
- said decorative insert fixed within hollow interior with said insert viewable through said top opening (photograph 9 is covered with plastic panel 30, thus is inherently viewable through top opening formed by 25).

Further Re claim 139: The method is inherently taught by the apparatus, as further detailed in column 2 lines 34-44 and column 3 lines 60-64. Examiner notes that there is no other opening to insert the photograph except the top opening; i.e., the base and sidewalls are a unitary solid structure.

Further Re claim 145: The entire locket 1 can be considered the base member, and top/front 2 and bottom/back 3 can be considered the plurality of segments. Column 3 lines 9-12 disclose that front /top 2 has a structure similar to that described regarding back/bottom 3. Fig 4 shows decorative insert 9 in bottom section 3, and decorative insert 9' in top section 2. When locket 1 is opened, 25 and 25' are top openings of 3 and 2 respectively.

Further Re claim 146: Examiner is considering the photograph, 9 or 9', to meet the limitation "plate-shaped", as examiner considers "plate-shaped" to mean substantially thinner than the diameter or perimeter length, and that any outline can be considered plate-shaped.

Re claims 132 and 140: A support member fixed to said base member within said hollow interior (toughened area 40, Fig 7, comprising projections and indentations which helps to support and retain decorative item 9, column 3 lines 55-64) and wherein said decorative insert is captured within said base member between said base member top and said support member. Note that, comparing Figs 5 and 6, the insert 9 extends in Fig 5 to the undercut groove (labeled by examiner above), described in column 2 lines 19-25 as extending "under the annular wall of the cover",

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and that when decorative photo 9 is placed into hollow section as shown in Fig 5, it would be atop 40 and thus it would be between top 25 and support 40.

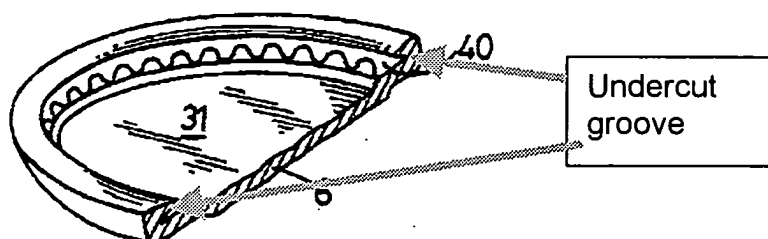


FIG 7

Further Re claim 140: The method is inherent in the apparatus, as further detailed in column 2 lines 34-44 and column 3 lines 60-64. Examiner notes that there is no other opening to insert the photograph except the top opening; I.e., the base and sidewalls are a unitary solid structure.

Re claims 133 and 141: The decorative insert as in claim 132, further comprising that the decorative insert (photograph 9) is fixed to said support member within said base member by a process selected from the group consisting of adhesive, soldering, welding, bonding, swaging, bending and clamping. The decorative insert photograph 9 is inherently clamped when it is placed between the bottom 6 and plastic cover 30. Further, the decorative insert photograph 9 is inherently bent and/or swaged when inserted, as seen best in Fig 4 and would inherently occur when the projections and indentations of 40 engage the photograph.

Further Re claim 141: The method is inherent in the apparatus, as further detailed in column 2 lines 34-44 and column 3 lines 60-64. Examiner notes that

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there is no other opening to insert the photograph except the top opening; i.e., the base and sidewalls are a unitary solid structure.

Re claim 136: As best understood by examiner, the support member of claim 133 comprises a "plate-like" member fixed within said base member below said top as shown in Fig 7. Examiner is assuming "plate-like" to mean relatively thin relative to the diameter or circumference.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 134, 135, 137, and 142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of Fitzgerald US Patent 901333.

Re claims 134-135 and 137 and 142: As discussed above, Taylor teaches all the elements except the decorative insert having a rear-projecting pin from its plate-like top and a support member having a hole for receiving said pin, with the pin being fixed to said support member by a process selected from the group consisting of adhesive, soldering, welding, bonding, swaging, bending and clamping. While it is true that Taylor is concerned with minimizing the locket thickness, Taylor has a recess 8 that curves such that it is deeper in the center than at the circumference. Further, column 1 lines 58-61 disclose that the recess may be adapted to fit different decorative inserts,

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including pictures, decorated plates, panels, etc., so that not all anticipated inserts can be considered flexible paper.

Fitzgerald teaches a decorative jewelry item with a base member and an insert, but is unconcerned with whether or not the insert extends above the sidewalls/top surface. In addition, Fitzgerald further teaches in Figures 4, 7, 8, and 14 that the insert has a rear-extending pin (male post 26) and that the base member 1 has a support member (formed from 11 and 12) with a hole therethrough (15a) for receiving said pin (26), described in page 1, column 2, lines 81-96 and page 2 column 1 lines 45-61, which further describe that the retainer (ball or knob 27) connected to the end of the pin (26) is pushed through hole (15a), spreading apart or bending the supports (11 and 12) to allow the ball to enter and then bending back to fix the pin to the support (page 2 column 1 lines 45-61).

Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Taylor and Fitzgerald before him at the time the invention was made, to modify Taylor as taught by Fitzgerald to include the pin and hold coupling of Fitzgerald, in order to obtain a secure and fixed assembly, while still permitting interchangeability of decorative items. One would have been motivated to make such a combination because a finished, custom look with secure but interchangeable inserts would have been obtained, as taught/suggested by Fitzgerald in page 2 column 1 lines 60-61 and page 2 column 2 lines 72-76. Further, accurately centering the decorative insert despite its interchangeability would have been obtained, as taught by Fitzgerald in page 2 column 1 line 50.

Further Re claim 135: Fitzgerald's ball or knob (27) serves as the retainer, which is affixed to pin below said support member (Fig 14). As further shown in Fig 14, there would inevitably be some slight slidability of pin, since the pin slides in and out thru hole 15a, and the pin would be rotatable, since it is a round pin in a round hole.

Further Re claim 137: The support member comprised of (11) and (12) can be considered a "plate-like" member, as a property of a plate can be considered any reinforcing or strengthening support:

plate (plāt) *noun*

plat·ed, plat·ing, plates

2. To cover with armor plate: *plate a warship*.¹

It is shown in Fig 14 as fixed within said base member (3) below said top with a hole (15a) therethrough.

Further Re claim 142: Fixing said pin to said support member by a process selected from the group consisting of adhesive, soldering, welding, bonding, swaging, bending and clamping is described by Fitzgerald in page 1, column 2, lines 81-96 and page 2 column 1 lines 45-61, which further describe that bending and swaging are used to fix the pin to the support, in that the retainer (ball or knob 27) connected to the end of the pin (26) is pushed through hole (15a), spreading apart or bending the supports (11 and 12) to allow the ball to enter and then bending back to fix the pin to the support (page 2 column 1 lines 45-61).

¹ *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction and distribution restricted in accordance with the Copyright Law of the United States. All rights reserved.

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17. **Claim 147 is rejected** under 35 U.S.C. 103(a) as being unpatentable over

Taylor. Applicant states in page 43 of the application that:

"...the decorative objects, and the decorative inserts may, independently, be circular, square shaped, diamond shaped, heart shaped, and the like. Any combination of these and other geometric shapes are intended to be within the scope of the invention.

Likewise, it is contemplated that the designer may select for the base members, caps, objects, and inserts, surface features such as serrated surfaces, smooth surfaces, faceted surfaces, planar surfaces, convex surfaces, concave surfaces, cubical surfaces, straight peripheral sides, stepped peripheral sides, as well as other shapes as described herein, including combinations of such features in a virtually limitless number of arrangements and presentations....

As described, the decorative objects and exposed surfaces of the stepped portion of the base units have preferred surface textures as shown and described. However, at the discretion of the designer, any or selected ones of such surfaces may be faceted, knurled, smooth, shiny, colored, frosted, or formed with diffraction gratings or filigree patterns, or may have thereon random markings, organized markings, and/or may be textured to simulate real gems."

Taylor teaches that not just photographs or pictures, but also decorative panels and plates, etc can be used as the decorative insert in column 1 lines 58-61. Absent some showing of criticality, the claimed shapes are nothing more than several of numerous shapes a person of ordinary skill in the art at the time the invention was made would have found obvious for the purpose of enhancing decoration and simulation effects. In re Dailey 149 USPQ 47 (CCPA 1976).

Allowable Subject Matter

18. Claims 143 and 144 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

19. Applicant's arguments with respect to claims 131-137, and 139-147 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

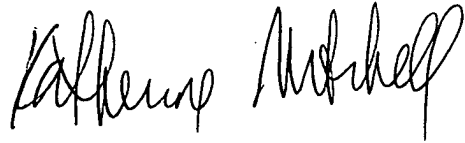
20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W Mitchell whose telephone number is 703-305-6713. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Katherine W Mitchell
Patent Examiner
Art Unit 3677

Kwm
8/4/2004